

**REMARKS**

In the subject Office Action dated August 22, 2005, claims 1-5, 7, 8, 12, 13 and 15 were examined. In response thereto, Applicants have amended claims 1, 7, 12 and 13. Applicants assert that all amendments are supported by the originally filed Specification and do not introduce new matter. Moreover, Applicants provide these amendments pursuant to 37 CFR § 1.116 and aver that the amendments do not introduce new issues.

In the subject Office action, claims 1-5,7,8,12,13 and 15 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner indicated that in claims 1,7,12 and 13 it is not clear which plane the articulation takes place in. Furthermore, in claim 1 and 12 and from the drawings it appears that the plane of movement is coaxial and not bisecting the axis of the longitudinal shaft. Applicants appreciate the suggestion by the Examiner that the claims should be clarified by defining the plane of movement in the independent claims. Applicants further appreciate the indication that Claims 7 and 13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

In response thereto, Applicants have amended each independent claim 1, 7, 12 and 13 to replace the description of the articulation movement as a *coaxial movement* rather than *in a plane bisected by the longitudinal axis of the shaft*. The claims were further amended by adding clarifying language as follows: *wherein a distal longitudinal axis defined through the end effector and a proximal longitudinal axis defined through the shaft remain coplanar during articulation*. Applicants respectfully assert that these amendments should clarify the planes of movement of the end effector. Reconsideration and withdrawal of the objection to claims 7 and 13 is respectfully requested.

As for substantive rejections in the subject Office action, claims 1-3,5-8,12 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Green (US 5,312,023) in view of Bolanos et al. (US 5,575,799). Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Green and Bolanos in further view of McGarry et al. (US 5,289,963).

Applicants assert that the clarifications made to independent claims 1 and 12 as to plane of movement of the articulation are made in a similar fashion to claims 7 and 13 that were directed to allowable subject matter. With this clarification, the cited references fail to teach or suggest a rotation motion that causes an articulation of the end effector in a coaxial motion remaining coplanar with a proximal portion of the shaft. In particular, Bolanos teaches an end effector that articulates in an arcing movement, changing in both lateral and vertical position in space. Clinicians may find this type of movement spatially difficult to interpret within the visual tools available in endoscopic or laparoscopic surgery. In addition, the insufflated body cavity or lumen may make such movement undesirable. The cited references fail to provide a suggestion or motivation to modify a combination of Green and Bolanos to move in a coaxial manner.

Consequently, reconsideration and allowance of independent claims 1 and 12 is respectfully requested, as well as claims 2-5, 8, and 15 that depend therefrom.

### **Conclusion**

In light of the amendments and remarks made herein, it is respectfully submitted that the claims currently pending in the present application are in form for allowance. Accordingly, reconsideration of those claims, as amended herein, is earnestly solicited. Applicants encourage the Examiner to contact their representative, David Franklin at (513) 651-6856 or [dfranklin@fbtlaw.com](mailto:dfranklin@fbtlaw.com).

Although no fees are believed to be due, the Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

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**CERTIFICATE OF MAILING**

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